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| 09/490,540      | 01/25/2000  | Shlomo Kipnis        | NDS-300.USA         | 7274             |

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EXAMINER

POINVIL, FRANTZY

ART UNIT PAPER NUMBER

3628

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/490,540

Applicant(s)

KIPNIS ET AL.

Examiner

Frantzy Poinvil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/4/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 13, 15, 16, 18-27 and 41-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13, 15, 16, 18-27 and 41-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 15, 16, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao et al. (US Patent No. 6,529,725) considered with Hultgren (WO 98/47116).

As per claims 1, 15, 26 and 27, Joao et al teach a portable transaction device comprising a transaction apparatus operative to participate in a monetary transaction. Joao et al also teach an authorization means/apparatus to authorize the transaction (column 5, lines 20-27). Joao further discloses a control apparatus operative to store the stored authorization parameters. The parameters may be an identity of a user. The system further comprises storing a type of transaction, a location and a time period during which a user is authorized to use the portable transaction device. Applicant is directed to column 7, lines 47-67 of Joao et al.

Joao et al do not explicitly disclose "proximity determination apparatus operative to determine a distance between the portable transaction device and a predetermined location, wherein the distance comprises a maximum distance from the predetermined at which the portable transaction is authorized to be used.

Hultgren discloses a tele/datacommunications payment method and apparatus. The system comprises means for determining the coordinates of a predetermined location and the

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coordinates of a portable transaction system. The two coordinates are compared and if the comparison result is within an acceptable range, the transaction is approved, otherwise, the transaction is denied. The distance being a maximum distance from the predetermined location at which the portable transaction device is authorized to be used would have been obvious to the skilled artisan in order to determine the range in relation to a predetermined location at which a transaction is authorized. See page 21 of Hultgren. It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Hultgren into Joao et al because Joao et al suggest that any limitations or restrictions regarding a particular geographical area may be used. Thus, incorporating the teachings of Hultgren in the system of Joao et al would have been obvious to one of ordinary skill in the art in order to limit usage of a portable transaction device to an acceptable range from a predetermined location thus preventing unauthorized usages of the portable transaction device.

As per claim 2, note also column 8, lines 1-35 of Joao et al.

As per claims 3-4 an identification or password is supplied prior to an authorized usage of the transaction device.

As per claim 5, the transaction device may be a smart card that contains a keypad.

As per claim 15, note the teachings referenced above. Furthermore, applicant argues that the authorization apparatus is operative to authorize use of the portable element up to a

quantitative use limit, and the use limit is a function of at least one of the following: an elapsed time since a predetermined time; a fixed time; a distance from a specified location; a type of transaction; and an identity of an authorized person authorized to use the portable element". In response, the distance from a specified location is the acceptable range described by Hultgren is a quantitative value. Hultgren also discloses the time limit is a specific day, date, time of the day, time of the month or year or a type of transaction which are a quantitative limit (column 7, lines 48-67).

As per claim 16, the combined system further comprises storing a type of transaction, a location and a time period during which a user is authorized to use the portable transaction device. Applicant is directed to column 7, lines 47-67 of Joao et al.

2. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao et al. (US Patent No. 6,529,725) and Hultgren (WO 98/47116) as applied to claim 1 above, and further in view of Sehr (US Patent No. 6,325,292).

As per claims 6-8, the teachings of Joao et al and Hultgren are discussed above. Joao et al and Hultgren do not explicitly state an input device comprising a voice recognition, a biometric or a fingerprint. Sehr teaches a financial transaction device comprising an input device comprising a keyboard (inputting device), and a touch screen (physical recognition device).

Note the abstract and column 6, lines 9-18 of Sehr. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Sehr into Joao

et al and Hultgren in order to provide a plurality types of identification therein. The motivation would have been to enhance the security of the Joao et al and Hultgren system.

3. Claims 9-10, 11, 13, 18-19 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao et al. (US Patent No. 6,529,725) and Hultgren (WO98/47116) as applied to claims 1 and 15 above, and further in view of Foladore et al. (US Patent No. 5,914,472).

As per claims 9-10, 11, 13, 18, 19, the teachings of Joao et al and Hultgren are discussed above. Joao et al and Hultgren do not explicitly teach having a plurality of users assigned to use the transaction device. Foladore et al disclose a credit card spending authorization system wherein a parent being the primary holder of an account, supplies an ancillary card to a child. Note column 2, lines 34-58 of Foladore et al. Authorization of a new user and the identity of a user who is authorized to use the transaction device is determined. Note column 3, line 65 to column 4, line 57 of Foladore et al. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Foladore et al into Joao et al and Hultgren in order to provide a purchasing transaction card to a child in case the child is out of state or in a different location from their parents in order to set a spending limit.

As per claims 22-23 both Joao et al and Foladore et al determine a transaction limit and a predetermined monetary limit to be used.

As per claims 24-25, Foladore et al disclose this claimed limitation. Note columns 4-5 of Foladore et al.

4. Claims 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao et al. (US Patent No. 6,529,725) and Foladore et al. (US Patent No. 5,914,472).

Furthermore, as per claims 42 and 43, the teachings of Joao et al are discussed above as providing teachings of an input apparatus operative to receive a user-identifying input and at least one user selectable use limitation from a user of the portable device. See also column 7, lines 40-67 of Joao et al. Joao et al do not explicitly teach a use limit, operative to limit use of the portable device in accordance with the at least one user selectable use limitation is determined to be an authentic control user by the user determination apparatus. Foladore et al teach this feature. Applicant is referred to column 5, line 8 to column 10, line 4 of Foladore et al. Joao et al and Foladore et al disclose user determination apparatus operative to determine whether the use is an authentic control user based, at least in part, on the user-identifying input and on the information stored in the control user identity unit (see column 10, lines 31-41 of Joao et al and column 5, line 8 to column 10, line 4 of Foladore et al). Furthermore, Foladore et al disclose providing the authorization of a new user and the identity of a user who is authorized to use the transaction device is determined. Note column 3, line 65 to column 4, line 57 of Foladore et al. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Foladore et al into Joao et al in order to provide a purchasing transaction card to a child in case the child is out of state or in a different location from their parents in order to set a spending limit.

Steps or means for limiting use of the portable device in accordance with the at least one user selectable use limitation if the user is determined an authentic control user by the determination apparatus is taught by Foladore et al on column 2, line 34 to column 3, line 22 of Foladore et al.

The use limitations comprise a type of transaction or a defined period of time. See column 7 of Joao et al or an authorized person (see column 8, lines 18-36 of Joao et al and column 2, line 34 to column 3, line 22 of Foladore et al).

As per claims 44 and 45, Joao et al disclose the transaction limit is an authorized transaction limit which is a quantitative limit (see column 5, line 62 to column 6, line 6 of Joao et al.).

5. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao et al. (US Patent No. 6,529,725) and Hultgren (WO 98/47116) as applied to claim 15 above, and further in view of Remillard (US Patent No. 5,561,709).

As per claims 20 and 21, the teachings of Joao et al and Hultgren are discussed above with respect to claim 1. Joao et al and Hultgren do not explicitly teach the portable element comprising a control device for controlling electronic equipment such as a television remote control device. Remillard discloses a financial apparatus that may be used as an electronic equipment such as a remote control device. Note the abstract of Remillard.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Remillard into Joao et al and Hultgren in order to determine usage



of a control equipment thereby, limiting usage of a control equipment such as a remote control or a financial device.

6. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao et al. (US Patent No. 6,529,725) and further in view of Remillard (US Patent No. 5,561,709).

As per claim 41, the teachings of Joao et al are discussed above. Joao et al. do not explicitly teach the portable element comprising a control device for controlling electronic equipment such as a television remote control device. Remillard discloses a financial apparatus that may be used as an electronic equipment such as a remote control device. Note the abstract of Remillard.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Remillard into Joao et al. in order to determine usage of a control equipment thereby, limiting usage of a control equipment such as a remote control or a financial device.

7. Claims 46-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao et al. (US Patent No. 6,529,725) and Foladore (US Patent No. 5,914,472) as applied to claim 42 above, and further in view of Sehr (US Patent No. 6,325,292).

As per claims 46-49, the teachings of Joao et al. and Foladore et al are discussed above. Joao et al and Foladore et al do not explicitly state an input device comprising a voice

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recognition, a biometric or a fingerprint. Sehr teaches a financial transaction device comprising an input device comprising a keyboard (inputting device), and a touch screen (physical recognition device). Note the abstract and column 6, lines 9-18 of Sehr. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Joao et al. and Foladore et al into Sehr in order to provide a plurality types of identification therein. The motivation would have been to enhance the security of the Joao et al and Foladore et al. system.

### **Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday 7:00AM-5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9326 for Before Final actions and (703) (872-9327). .

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

FP  
January 31, 2004

*Frantzy Poinvil*  
FRANTZY POINVIL  
PRIMARY EXAMINER  
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